

**REMARKS**

Claims 1 - 14 remain in this application. Claims 1 - 14 are rejected. Claims 1 and 3 - 8 are amended herein to clarify the invention, to more particularly point out and distinctly claim the subject matter which the Applicant regards as the invention, and to address matters of form in the original claims unrelated to substantive patentability issues. No new matter is added by any of the amendments to the claims. Support for the amendments to the claims is found in the original specification, *passim*.

In the Office Action, previous claims 7 - 14 were rejected under 35 U.S.C. 112, second paragraph, for allegedly being indefinite as method claims without reciting positive steps as to how the method is practiced.

Applicant respectfully submits that previous claims 7 - 14 were incorrectly interpreted as method claims due to awkwardness in the translation of those claims from the original Japanese language version of those claims. Those claims should correctly be interpreted as composition claims drawn to printed matter comprising the ink recited according to claims 1 and 2, respectively, for claims 7 and 8; with claims 9, 11, and 13 depending either directly or through intervening claims from claim 7; and claims 10, 12, and 14 depending either directly or through intervening claims from claim 8.

Accordingly, the 35 U.S.C. 112, second paragraph based rejections of previous claims 7 - 14 are believed to have been overcome.

In the Office Action, previous claims 7 - 14 were rejected under 35 U.S.C. 101 for allegedly seeking to define a process without setting forth any steps involved in the process.

Applicant again submits that this rejection has been mistakenly made based on an incorrect interpretation of the nature of previous claims 7 - 14 as being process claims due to awkwardness in the initial translation of the original Japanese claims. Applicant again reiterates that these claims are correctly interpreted as composition claims drawn to printed matter comprising the respective ink compositions of claims 1 and 2, as discussed herein above. Accordingly, this rejection is believed to have been rendered moot and/or to have been successfully overcome by the amendments to claims 7 - 14 presented herein above.

In the Office Action, previous claims 1 - 6 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent 5,037,475 to Chida et al ("Chida") in view of U.S. Patent 5,176,746 to Nakanishi et al ("Nakanishi").

The Examiner contends that Chida discloses a colored metallic pigment comprising all of the components and having all of the features of the inks of the present application as recited according to claims 1 and 2, except for disclosing the use of 3-methyl-3-methoxy-1-butanol as the solvent.

The Examiner further contends that Nakanishi discloses the use of various solvents, including the aforesaid 3-methyl-3-methoxy-1-butanol in ink compositions, so that it would have been obvious to a person of ordinary skill in the relevant art at the time the present invention was made, to use that solvent according to Nakanishi in an ink composition according to Chida, and that the result would have been the ink compositions according to previous claims 1 - 6 of the present application.

Applicant respectfully disagrees with the Examiner's analysis of these above two mentioned references and the conclusion that the claims of the present application would have been obvious to a person of ordinary skill in the relevant art to which the present invention pertains at the time the present invention was made, based on a combination of these references.

Claims 1 - 6 are rejected under 35 U.S.C. 103(a) as unpatentable over U.S. Patent 5,037,475 to Chida et al ("Chida") in view of U.S. Patent 5,176,746 to Nakanishi et al ("Nakanishi"). The Examiner states that Chida discloses a colored metallic pigment comprising a metallic pigment, a coloring pigment, a thermally polymerized carboxylic acid having at least one double bond, and an organic solvent, for use as an ink. The Examiner recognizes that Chida fails to disclose 3-methyl-3-methoxy-1-butanol as the particular solvent, but notes that Nakanishi discloses the use of that compound as a solvent for an ink, so that it

would have been obvious to a person of ordinary skill in the art at the time the present invention was made to use 3-methyl-3-methoxy-1-butanol as the organic solvent in the ink composition according to Chida, which, the Examiner contends, results in the same composition as that according to the present application. Accordingly, Applicant respectfully traverses this rejection based on the following arguments and remarks.

The basic ink composition according to Chida requires the presence of a carboxylic acid polymer and a non-metallic coloring pigment. The ink composition according to claims 1 - 6 of the present application does not require these components. Moreover, there is nothing in Chida that teaches, discloses, or suggests that at the carboxylic acid polymer or the non-metallic coloring pigment can be eliminated. Also, it would not have been obvious from Nakanishi to use 3-methyl-3-methoxy-1-butanol as the solvent in the ink compositions of Chida because Nakanishi, unlike the present invention, relates to an *oil* based ink. Applicant has made the inventive discovery that the use of 3-methyl-3-methoxy-1-butanol is advantageous because using that solvent in applicant's ink composition containing does not damage a polycarbonate substrate (see second paragraph at page 6 of the present specification).

Claims 1 and 3 - 6 have also been amended to utilize "consisting essentially of" language in place of "comprising".

Therefore, Applicant respectfully submits that amended claims 1 - 6 patentably distinguish over Chida in view of Nakanishi and that the 35 U.S.C. 103(a) based rejection applied to the previous claims should be withdrawn, and is not applicable to any of amended and original claims 1 - 6 as presented by this Amendment.

No additional claims fees are due with the filing of this Amendment.

This Amendment is being filed within the original three month shortened statutory period for response. Therefore, a Request for an extension of time is not required and no fee for an extension of time is due.

In light of the foregoing, the application is now believed to be in proper form for allowance of all claims and notice to that effect is earnestly solicited.

No other fees are believed due with the filing of this Amendment. If, however, any additional fees are due, or if Applicant is entitled to a refund of any previously made overpayments, they should be respectively charged and credited to Deposit Account No. 10-1250.

Respectfully submitted,  
JORDAN AND HAMBURG LLP

By C. Bruce Hamburg  
C. Bruce Hamburg  
Reg. No. 22,389  
Attorney for Applicants  
and,

By Howard R. Jaeger  
Howard R. Jaeger  
Reg. No. 31,376  
Attorney for Applicants

Jordan and Hamburg LLP  
122 East 42nd Street  
New York, New York 10168  
(212) 986-2340